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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,338	02/28/2000	Jun Tanabe	00724/P11-225315/AM/CUB/U	8391
<div>7590 09/13/2007 Wenderoth Lind and Ponack 2033 K street N.W. SUITE 800 Washington, DC 20006</div>			<div>EXAMINER KIM, CHONG HWA</div>	
			<div>ART UNIT 2167</div>	<div>PAPER NUMBER</div>
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/514,338

Applicant(s)

TANABE ET AL.

Examiner

Chong H. Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Jun 29, 2007 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 15-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15 and 30 recites the newly included limitation, "one type of material". Such language is considered indefinite because it is not clear what is meant by "one type". The specification does not expound on what it means by the words "one type" and it is not clear whether this "one type" of material comprises/consists the thermosoftening synthetic resin material only or blended with woodmeal and/or with color pigment. Furthermore, it is not clear what it means by the word "type". Such word is not clearly defined in the specification as originally filed.

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***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 15-19, 21, 24, 27, and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakada et al., U.S. Patent 5,792,302 in view of Nishibori, U.S. Patent 5,869,138.

Nakada et al. shows, in Figs. 1-5, a steering wheel comprising;

an annular rim 1a including;

a core 2 that is an arcuate-shaped metal rod;

arcuate-shaped and elongated rim elements 3, 4 mounted on the core 2, each of the rim elements having an inner surface contacting the core (see Figs 1 and 3);

wherein an annular streak pattern (as shown in Fig. 3B) extends along a

longitudinal axis of each of the elongated rim elements;

a boss section (in the middle of the spoke section 1b) and a spoke section 1b, the annular rim section 1a being connected to the boss section by the spoke section 1b;

wherein the arcuate rim elements include a front-side rim element having a central longitudinal groove 13, and include a rear-side rim element having a central longitudinal groove 13, the core 2 being fit into the central longitudinal groove 13 of each of the front-side rim element and the rear-side rim element so as to mount the rim elements 3, 4 on the core 2 (as shown in Figs. 3-6);

wherein the arcuate rim elements include an outer-side rim element having a central longitudinal groove 13, and include an inner-side rim element having a central longitudinal groove 13, the core 2 being fit into the central longitudinal groove 13 of each of the outer-side rim element and the inner-side rim element so as to mount the rim elements 3, 4 on the core 2 (as shown in Figs. 3-6), and the rim elements having a uniform thickness (the rim element 3) substantially equal to a diameter of the core;

a coating covering the arcuate rim elements 2, 4 (as described in column 9, lines 31-5);  
and

wherein the annular rim section further includes a grip portion 25 formed of flexible urethane and mounted on the core 2 (as described in column 8, lines 56-61 and in column 7, lines 9-11);

but fails to show the rim elements being formed of thermosoftening synthetic material blended with woodmeal so as to have an outer surface of the thermosoftening synthetic resin material and the woodmeal, with an outer surface streak pattern and a color pigment blended therein to show different colors wherein the rim section has surface unevenness.

Nishibori teaches, in column 2, lines 4-20, one type of material that is made of a thermosoftening synthetic resin (thermoplastic resin) blended with wood meal so as to form a streak pattern (wooden pattern) on an outer surface and wherein a color pigment (colorant) is blended therein so as to have an outer surface of the thermosoftening synthetic resin material and the wood meal, with an outer surface streak pattern, that is defined by the woodmeal within the resin material, on the outer surface includes streaks of different color, and the surface having a surface unevenness.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the steering wheel rim elements of Nakada et al. with the one type of material being made of thermosoftening synthetic resin including wood meal and color pigment of Nishibori in order to provide a molded product that contains the wooden grain that of the natural wood with reduced cost compared to the real wood laminated onto a molded surface.

6. Claims 20, 22, 23, 25, 26, 28, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakada et al. in view of Nishibori as applied to claims 15, 19, 21, and 24 above, and further in view of Young, Jr. et al., U.S. Patent 3,802,291, in view of Kiyoshi, JP Pub No. 07117326, and in view of Uchida, U.S. Patent 4,581,954.

Nakada et al. in view of Nishibori shows, as discussed above in the rejection of claims 15, 19, 21, and 24, the steering wheel comprising the arcuate-shaped and elongated rim elements formed of thermosoftening synthetic material blended with wood meal so as to form an annular streak pattern on an outer surface thereof, but fails to show a cover member mounted on the seam; the protective coating covering only the front-side portion of the arcuate rim element; a transfer print on a front-side of the annular rim section; and the arcuate rim elements having the first rim having a notch for receiving the core and the second rim having the substantially equal thickness to the diameter of the core to be fitted in the notch.

As to the matter of the cover member mounted on the seam, Young, Jr. et al. shows, in Fig. 3, a steering wheel comprising a seam wherein a cover 106 is mounted on the seam.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the cover as taught by Young, Jr. et al. on the seam of Nakada et al.

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in view of Nishibori in order to provide a more pleasing design so that the value of the product is maintained.

As to the matter of the protective coating covering only the front-side portion of the arcuate rim element, it would have been obvious to modify protective coating of Nakada et al. in view of Nishibori by having the protective coating covering only the front-side portion of the arcuate rim element, since applicant has not disclosed that having the protective coating covering only the front-side portion of the arcuate rim element solves any stated problem or is for any particular purpose and it appears that the protective coating would perform equally well by covering other parts of the rim.

As to the matter of the transfer print on a front-side of the annular rim section, Kiyoshi, discloses, in Figs. (a)-(c) and in the Abstract, a steering wheel comprising transfer print on a front-side of the annular rim section wherein the transfer print includes a transfer ink layer having a thickness gradually reduced toward a rear-side of the annular rim section so that a ground pattern formed by the transfer ink layer gradually appears on the annular rim section when viewed from the rear-side toward the front-side.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the rim of Nakada et al. in view of Nishibori with the transfer print of Kiyoshi in order to “raise a decorative design of a product, and a seam of a transfer pattern is made difficult to be visually confirmed” as described in the Purpose of the Abstract by Kiyoshi.

As to the matter of the arcuate rim elements having a first rim having a notch for receiving the core and a second rim having a substantially equal thickness to the diameter of the

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core to be fitted in the notch, Uchida shows, in Fig. 5, a steering wheel comprising an arcuate rim elements 10' include a first rim element 11 having a longitudinal notch formed therein for receiving the core 7, and a second rim element 114 having a thickness (near the core 7) substantially equal to a diameter of the core 7 and being fitted into the notch of the first rim element 11 after the core.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the two halves of Nakada et al. in view of Nishibori with the cover assembly of Uchida in order to provide a more securely engaged mechanism so that the steering wheel would last longer.

### ***Response to Arguments***

7. In response to the applicant's argument (1), it is the Examiner's view that the recitation "one type of material" is confusing and unclear, making the language indefinite as discussed above. Nevertheless, it is the Examiner's intention (changed due to the applicant's amendment) to modify the rim elements comprising the layers 3 and 4 (which could be interpreted to be "one type of material") of Nakada et al. with the one type of material as disclosed by Nishibori. Such different interpretation would make the applicant's arguments moot, since the rim elements would be touching the core 2 and the thermosoftening synthetic resin material blended with woodmeal and color pigment as taught by Nishibori could be construed to be "one type of material" (depending on the meaning of such language).

8. In response to the applicant's argument (2) regarding the modification of the arcuate-shaped rim element in the primary reference with the "flat" board as taught by the secondary

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reference, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Certainly, one of ordinary skill in the art could make the “one type of material” as taught by Nishibori in an arcuate-shaped and elongated rim elements so that the rim elements can be fit onto the core of Nakada et al. The bending process of the board, as the applicant suggested, may not be necessary since such bending process is not the only method to make the material in an arcuate shape. The task of forming an arcuate shape does not require extraordinary know-how or skill. As long as the “one type of material” is taught, one of ordinary skill in the art could make any possible shape or form by known cutting or molding processes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chong H. Kim whose telephone number is (571) 272-7108. The examiner can normally be reached on Monday - Friday; 9:00 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

chk  
September 5, 2007



CHONG H. KIM  
PRIMARY EXAMINER